

Application No.: 09/613,028  
Reply to Office Action of: January 10, 2005

### REMARKS

In response to the final Office Action dated January 10, 2005, Applicants are submitting a Request for Continued Examination (RCE) with a preliminary amendment requesting the Examiner's continued consideration. It is noted that claims 1-49 are pending and stand rejected in the last office action. However, in a amendment dated July 20, 2004, prior counsel indicated that claims 7-10, 17-20, 29-32 and 42-45 were previously withdrawn from further consideration pursuant to 37 C.F.R. Section 1.142(b). The listing of the claims included here reflects this status. Accordingly, the claims that are addressed here are the rejected claims 1-6, 11-16, 21-28, 33-41 and 46-49. If the Examiner disagrees with this status, he is requested to advise the undersigned immediately. By this preliminary amendment, Applicants have amended the rejected claims and presented arguments that further distinguish those claims from the prior art that is applied by the Examiner.

#### Claim Rejections – 35 USC § 112

In paragraph 2 of the office action, claims 1-49 are rejected under 35 U.S.C. Section 112, first paragraph, as failing to comply with the written description requirement. The Examiner indicates that the specification as originally filed does not disclose the new claim limitations of claims 1, 11, 23, and 36, "wherein said data input...and is in an unabutted location relative to a perimeter of a display device." Applicants respectfully submit that the drawing figures that were originally filed, which constitute part of the disclosure clearly illustrate this limitation.

The Examiner is respectfully requested to withdraw his rejection of claims 1-49 under 35 U.S.C. Section 112.

#### Claim Rejections – 35 USC § 103

In paragraphs 4, 5, 6, 7, 8 and 9 of the office action, claims 1-5, 11-15, 23-27, and 36-40 are rejected under 35 U.S.C. Section 103(a) as unpatentable over Deeran et al. in view of Liao et al., as well as other secondary references discussed before (e.g., Matsui et al., Ganthier et al, and Sylvan et al.) in prior responses presented by prior counsel. Applicants hereby incorporate by reference distinctions urged with respect to those secondary references from the prior responses.

Applicants respectfully submit that for rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03. The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03. To resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references (Deeran and Liao) that meets the claimed limitations, but must also point to the motivation in the asserted references (Deeran and Liao) that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An Examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerasonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

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Applicants submit that Deeran discloses an industrial computer workstation for industrial use configured as a simple proprietary data input terminal allowing for central storage and analysis of data collected. Moreover, Deeran discloses a data input area/surface 18 with a template overlay 15 placed over it. Although the Examiner argues that a combination with Liao would have been obvious to one of ordinary skill, Applicants respectfully requests reconsideration of this argument based on the reasons urged above with respect to obviousness. Moreover, neither reference indicates a removable user input device to provide multiple methods of data input to a portable electronic system.

Based on the amended claims that are presented and the arguments on obviousness, Applicants respectfully request reconsideration of the claims that are rejected. The dependent claims are distinct from the asserted art at least for the reasons urged with respect to the independent claims from which they depend.

### ***Conclusion***

Respectfully, Applicants request the Examiner to consider the amended claims and invite the Examiner to telephone the undersigned representative if an interview might be useful for any reason to expedite allowance of this application.

Respectfully submitted,  
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